

**REMARKS/ARGUMENTS**

This is in response to the Action of October 26, 2005 having an extended period for response set to expire on February 26, 2005. Reconsideration of the present application in view of the above amendments and following remarks is respectfully requested.

The Abstract and paragraphs [0001], [0009], [0010], [0016], [0025], [0027], [0057], [0058], [0063], [0070], [0104] and [0116] in the description have been amended for editorial purposes.

Claims 1 to 12, 14, 15 and 23 to 49 are presently pending. Claims 16 to 22 have been withdrawn from consideration. Claims 4, 6, 27 and 42 have been amended, without prejudice. Applicants hereby reserve the right to pursue such claims as originally presented, or claims of a similar scope, in a related application. The amendments to the claims are supported by the claims as filed and in the specification.

**RESTRICTION OF CLAIMS 35 TO 41 AND 43 TO 49 IS IMPROPER**

The Examiner restricts claims 35 and 41 and 43 to 49 as same are allegedly "directed to an invention independent from that originally claimed", namely one in which the ethylenically unsaturated monomers are aromatic (Action, p. 2). Applicants respectfully submit that aromatic ethylenically unsaturated monomers were within the initially examined invention, and accordingly the restriction and withdrawal of claims 35 and 41 and 43 to 49 is improper.

Applicants note that the ethylenically unsaturated monomers originally examined included both aromatic and non-aromatic compounds in general, and specifically claimed aromatic compounds. The description of such monomers includes both "aliphatic vinyl compounds" and "aromatic vinyl compounds". (See paragraphs [0077] to [0079]). Further, previously examined claims 9, 11, 12, 28, 30 and 31 are specifically directed to a composition wherein the ethylenically unsaturated monomer is vinyl toluene, an **aromatic** compound. Accordingly, the

originally examined invention included both aromatic and non-aromatic ethylenically unsaturated monomers. As such, the restriction and withdrawal of claims 35 and 41 and 43 to 49 due to the fact that same are directed to aromatic monomers is improper. Reconsideration and withdrawal of the restriction requirement is respectfully requested.

#### **REJECTIONS UNDER 35 U.S.C. § 112**

The Examiner has rejected claim 42 under 35 U.S.C. § 112 as allegedly indefinite for being a duplicate of claim 8. (Action, p. 3). Applicants respectfully submit that this rejection is moot in view of the amendment to claim 42.

The Examiner has rejected claim 6 under 35 U.S.C. § 112 as allegedly indefinite for lacking sufficient antecedent basis with regard to the term "comprises acrylate that is at least tetra-functional". *Id.* Applicants respectfully submit that this rejection is moot in view of the amendments to claims 4 and 6.

The Examiner has rejected claim 27 under 35 U.S.C. § 112 as allegedly indefinite for lacking sufficient antecedent basis with regard to the term "acrylate comprises acrylate that is at least tetra-functional". *Id.* Applicants respectfully submit that this rejection is moot in view of the amendment to claim 27.

#### **DOUBLE PATENTING REJECTION**

The Examiner has provisionally rejected Claims 1 to 12, 14 to 15, 23 to 34 and 42 as being allegedly unpatentable over Claims 1 to 45 of co-pending Application No. 10/679,871 in view of U.S. Patent No. 5,891,942 to Parish et al. (hereinafter "Parish"). (Action, p. 3-4). Although applicants respectfully disagree, in the event that subject matter is found allowable, applicants will consider the filing of a terminal disclaimer.

#### **PROVISIONAL REJECTION UNDER 35 U.S.C. 103(a)**

The Examiner has provisionally rejected Claims 1 to 12, 14 to 15, 23 to 34 and 42 as being allegedly obvious over co-pending Application No. 10/679,871 (hereinafter "871 application"), which the Examiner alleges to be prior art if

published or patented. (Action, p. 5). Applicants respectfully traverse the present rejection as the '871 application is not available as art under 35 U.S.C. 102(e) and as the provisional rejection under 35 U.S.C. 103(a) is therefore not proper as explained below.

**A) The '871 Application is Not Available under 35 U.S.C. § 102(e)**

The present rejection is respectfully traversed as the '871 application is not available as prior art under 35 U.S.C. § 102(e). In general, an application is available for use as a 102(e) reference when it is invented by another, published, and filed in the U.S. before the invention by the applicant for patent. MPEP § 706.02. However, the '871 application was not filed before the filing date of the presently claimed invention and thus is not available as a 102(e) reference.

The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application. MPEP § 706.02(f)(1). The '871 application was filed on October 6, 2003 and claims priority to U.S. Provisional Application No. 60/425,091, filed on November 8, 2002. The present application was filed on October 6, 2003 and claims priority to U.S. Provisional Application No. 60/425,099, filed on November 8, 2002. Accordingly the '871 application and the present application both have an effective filing date of November 8, 2002; the classification of the '871 application as a reference under 102(e) is therefore improper.

**B) The 35 U.S.C. §103(a) Rejection is Improper**

The present rejection is respectfully traversed as, even assuming *arguendo* that the '871 application is available as prior art under 35 U.S.C. § 102(e) (which it is not), a provisional 35 U.S.C. § 103(a) rejection cannot be made using 35 U.S.C. § 102(e) prior art between commonly assigned applications. "[A] provisional rejection under 35 U.S.C. § 103(a) using prior art under 35 U.S.C. § 102(e) is not proper if the application contains evidence that

the application and the prior art reference were commonly owned or subject to an obligation of assignment to the same person, at the time the invention was made". MPEP § 2136.01 (citing *In re Irish*, 433 F.2d 1342, 167 USPQ 764 (CCPA 1970)). Both the '871 application and the present application list Illinois Tool Works Inc. as the assignee on their respective Application Data Sheets. Accordingly, the '871 application and the present application have a common assignee and thus the provisional 103(a) rejection is improper.

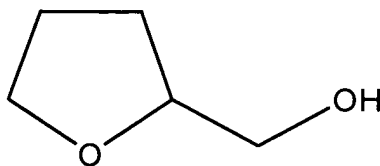
### **REJECTION UNDER 35 U.S.C. 103(a)**

The Examiner has rejected claims 1 to 7, 9 to 12, 14 to 15, 23 to 28, 30 to 34 and 42 under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent No. 5,965,635 to Rancich et al. (hereinafter "Rancich") in view of U.S. Patent No. 3,816,283 to Mani (hereinafter "Mani") or European Patent No. 0875546 to Parish et al. (hereinafter "Parish"). (Action, p. 5). The present rejection is respectfully traversed as such claims are patentably non-obvious over Rancich in view of Mani or in view of Parish.

#### **A. Claims 1 to 12, 14, 15 and 23 to 49 are Patentably Non-Obvious over the Combination of Rancich and Mani**

The present rejection is respectfully traversed as claims 1 to 7, 9 to 12, 14, 15 and 23 to 49 are patentably non-obvious over Rancich in view of Mani.

Rancich does not teach or suggest the presently claimed invention. Rancich discloses an adhesive composition comprising a methacrylate ester monomer, a methacrylic acid-methacrylic acid ester copolymer reactive with the monomer, a free radical catalyst, and an optional activator. (See Rancich, Col. 3, lines 15 to 67, Col. 4, lines 16 to 47). The methacrylate ester monomers detailed in Rancich include only mono-functional acrylates. (Id., Col. 3, lines 30 to 34). The Examiner's contention that tetrahydrofurfuryl ester of methacrylic acid is a multifunctional acrylate is incorrect (Action, p. 6). A structural diagram of tetrahydrofurfuryl is provided below:



As can be seen and appreciated from the above, tetrahydrofurfuryl is mono-functional and therefore the tetrahydrofurfuryl ester of methacrylic acid is a mono-functional acrylate. Further, the examples of Rancich only use methyl methacrylate as the monomer, clearly a mono-functional acrylate. (See Rancich, Col. 9, lines 56 to 57). Accordingly, Rancich does not disclose or suggest the multifunctional acrylate of the compositions of the present invention; one of ordinary skill in the art would not be motivated to select a multi-functional acrylate based on the disclosure of Rancich.

Rancich also does not disclose the composition of the present invention having a pull out performance after 1 hour at a temperature of 23°C of at least about 70 KN. The exemplified compositions of Rancich have a pull out performance after 2 hours of 1,310 and 6,000 lbs (5.83 and 26.69 KN, respectively), after 24 hours of 3,832 and 7,200 lbs (17.05 and 32.03 KN, respectively), and after 72 hours of 2,830 lbs (12.59 KN). (Id., Col. 11, lines 65 to 57, Col. 12, lines 46 to 49, Col. 15, lines 1 to 25). The pull out performance of the instant compositions is over double that of the highest pull out performance measurement of the Rancich compositions and was tested after less than half of the cure time allotted to the Rancich compositions. Accordingly, Rancich does not disclose or suggest an adhesive composition having the unexpected strength of the composition of the present invention; one of ordinary skill would not even be motivated to produce the present compositions, much less have the expectation that such desirable pull out performance values would be obtained.

The Examiner cites Mani for the provision of a reactive multifunctional acrylate. (Action, p. 6). The Examiner has acknowledged, by withdrawing the previous anticipatory rejection of the claims 1 to 15 and 23 to 34 over Mani, that same are patentable over Mani for the reasons espoused in the response to such

action. Namely, for at least the rationale that Mani fails to disclose a composition having a pull out performance after one hour at a temperature of 23°C of at least about 70 KN, and that Mani fails to disclose an adhesive composition having a reactive multifunctional acrylate wherein a major proportion of such acrylate is at least tri-functional. Applicants also note that claims 35 to 49 are directed to a composition containing an aromatic ethylenically unsaturated monomer, which Mani teaches is inoperative with the coating compositions disclosed therein (See Mani, Col. 3, lines 20 to 21).

Thus, even assuming *arguendo* that one of ordinary skill would be motivated to combine Rancich and Mani (which one would not), the combination of same does not produce the instantly claimed compositions. The combination of Rancich and Mani does not teach or suggest the pull out performance of the compositions of claims 1 to 12, 14 and 15, the major proportion of at least tri-functional acrylate of claims 23 to 34, or the aromatic ethylenically unsaturated monomer of claims 35 to 49. Accordingly, claims 1 to 12, 14, 15 and 23 to 49 are patentably non-obvious over Rancich in view of Parish for at least this rationale.

**B. Claims 1 to 12, 14, 15 and 23 to 49 are Patentably Non-Obvious over the Combination of Rancich and Parish**

This rejection is respectfully traversed as Applicants respectfully submit that claims 1 to 12, 14, 15 and 23 to 49 are patentably non-obvious over Rancich in view of Parish.

As noted above, Rancich does not teach or suggest adhesive compositions containing a multifunctional acrylate or compositions having a pull out performance after 1 hour at a temperature of 23°C of at least about 70 KN. The Examiner cites Parish for the provision of a reactive multifunctional acrylate. (Action, p. 6). Parish discloses a coating composition comprising a vinyl ester, a non-aromatic multifunctional acrylate which serves as a reactive diluent, a catalyst, and an optional activator. (See Parish, paragraphs [0006], [0008], [0012], [0016] and [0017]. Parish does not teach or suggest an adhesive composition having a pull out performance after **1 hour** at a temperature of 23°C

of at least about 70 KN, a major proportion of acrylate that is at least tri-functional, or aromatic ethylenically unsaturated monomer.

Even assuming *arguendo* that one of ordinary skill would be motivated to combine Rancich and Parish (which one would not), the combination of same does not produce the instantly claimed compositions. The combination of Rancich and Parish does not teach or suggest the pull out performance of the compositions of claims 1 to 12, 14 and 15, the major proportion of at least tri-functional acrylate of claims 23 to 34, or the aromatic ethylenically unsaturated monomer of claims 35 to 49. Accordingly, claims 1 to 7, 9 to 12, 14, 15 and 23 to 49 are patentably non-obvious over Rancich in view of Parish for at least this rationale.

**CONCLUSION**

In view of the above amendments and remarks, the present application is in condition for allowance and a Notice of Allowance is therefore earnestly solicited. The Office is invited to contact applicant's undersigned counsel by telephone to resolve any further matters in connection with this application.

A Credit Card Payment Form in the amount of \$120.00 for the fee for a one month extension is attached herewith. Furthermore, the Commissioner is hereby authorized to charge any fees which may be associated with this communication or credit any overpayment to Deposit Account No. 19-5425. A duplicate copy of this transmittal is attached.

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Respectfully submitted,



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